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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,263	04/23/2001	Hiroshi Kitada	202308US2X	1527

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EXAMINER
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NGUYEN, VAN H

ART UNIT	PAPER NUMBER
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2194

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/839,263

Applicant(s)

KITADA ET AL.

Examiner

VAN H NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-20,22-40 and 42-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-20,22-40 and 42-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/14/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 2-20, 22-40, and 42-55 are presented for examination.
2. It is noted that applicant has other related application (i.e., application 09/684,965 filed October 10, 2000). It is requested that any related application be referred to in the first sentence of the specification. Applicant is also requested to supply the serial numbers of any other related applications currently pending before the U.S Patent & Trademark Office.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claim 20 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 40, lines 1-15 and page 41, lines 7-17, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., hard disks and floppy disks) and intangible embodiments (e.g., transmission medium, radio wave, light waves, carrier wave). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

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6. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the bottom, carrier medium and transmission media would be not statutory but storage media would be statutory.

### ***Double Patenting***

#### **7. Obviousness-type double patenting rejection**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 2 is are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending application 09/684,965 filed October

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10, 2000 in view of Navarre et al. (U.S. 6, 442,611 B1).

11. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of instant application and claim 1 of copending application'965 are both claiming a system for communicating over a protocol; receiving a request; selecting an application service provider; transmitting instructions for performing the transaction request, via the communications network. The difference between claim 2 of instant application and claim 1 of copending application'965 is claim 2 of instant application further recites a document profile. Navarre teaches a document profile (col.4, lines 47-60 and fig. 3). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Navarre and copending application'965 because Navarre's teaching would have provided the capability for efficiently selecting an appropriate service provider to satisfy a request from a user.

12. As to the remaining claims 3-20, 22-40, and 42-55, they are also rejected under obvious type double patenting as stated in claim 1 above.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-20, 22-40, and 42-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Navarre et al.** (U.S. 6, 442,611 B1) in view of **Miller et al.** (U.S. 5, 475,819).

16. **As to claim 2**, Navarre teaches (abstract) the invention substantially as claimed including a method for managing applications service provider transactions (*transactions*) between an ASP (*server application*) and an ASP user (*a client application*), comprising:

receiving an ASP transaction request having a user identifier from the user via a communications network (col.2, line 50 - col.3, line 29 and fig. 3);

determining whether a document profile exists for the user identifier received (col.4, lines 47-60 and fig. 3);

sending to the user a document manager interface screen based on the determination of whether a document profile exists (col.4, lines 58-60); and

transmitting instructions for performing the transaction request, via the communications network (col.2, lines 50-65; col.3, lines 30-31; and fig.3).

Navarre does not specifically teach "selecting an ASP."

Miller teaches selecting an ASP (col.2, lines 9-25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Miller and Navarre because Miller's teaching

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would have provided mechanisms to automatically: (1) efficiently map a (flat) name of a service into a set of service providers; (2) customize the mapping of services into service providers based on a user, system, LAN, site, organization, etc.

17. **As to claim 3**, Navarre teaches determining whether a document profile exists comprises determining that a document profile does exist by locating a document profile associated with the user identifier in a memory which is local to a processing device which performs the step of determining whether a document profile exists (col.2, lines 26-49 and col.4, lines 47-60).

18. **As to claim 4**, Navarre teaches step of sending a document manager interface screen comprises sending an interface screen including a document profile menu that lists the document profile located in the memory (col.4, lines 47-60 and fig.4).

19. **As to claim 5**, Navarre teaches receiving a document profile selection from the user via the communications network based on a user input to the document profile menu (col.4, lines 47-60).

20. **As to claim 6**, Navarre teaches selecting a basic ASP using the document profile selection received (col.2, lines 26-49 and col.3, lines 1-29).

21. **As to claim 7**, Navarre teaches determining a document type using the document profile selection received; and selecting the basic ASP that performs services utilized with the document type (col.2, lines 26-49 and col.3, lines 1-29).

22. **As to claim 8**, Navarre teaches determining that a document profile does not exist by searching a memory which is local to a processing device which performs the step of determining whether a document profile exists (col.2, lines 26-49 and col.4, lines 47-60).

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23. **As to claim 9**, Navarre teaches the step of sending a document manager interface screen comprises sending an interface screen including a document type menu (col.4, lines 47-60).

23. **As to claim 10**, Navarre teaches receiving a document type selection from the user via the communications network based on a user input to the document type menu (col.4, line 47-col.5, line15).

24. **As to claim 11**, Navarre teaches the step of selecting an ASP comprises selecting a basic ASP that performs typical services utilized with the document type selection received (col.3, lines 1-29 and col.5, line 3-15).

25. **As to claim 12**, Navarre teaches creating a document profile based on the document type selection received; and storing the document profile in association with a user identifier in a local memory (col.4, lines 47-60 and fig.4).

26. **As to claim 13**, Navarre teaches the step of receiving an ASP transaction request comprises receiving a document consultation request from the user (col.2, line 66-col.3, line 29).

27. **As to claim 14**, Navarre teaches sending, in response to receiving the document consultation request, a document manager interface screen including a document type menu to the user via the communications network; generating a document type selection from a user input to the document type menu; and receiving the document type selection via the communications network (col.2, line 66-col.3, line 29 and col.4, lines 47-60).

28. **As to claim 15**, Navarre teaches the step of selecting an ASP comprises selecting a basic ASP that performs services utilized with the document type selection received (col.2, lines 26-49 and col.3, lines 1-29).



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29. **As to claim 16**, Navarre teaches creating a document profile based on the document type selection received; and storing the document profile in association with a user identifier in a memory (col.4, lines 47-60 and fig.4).
30. **As to claim 17**, Navarre teaches selecting a special service ASP for providing special services independently offered by an ASP (col.3, lines 1-45).
31. **As to claim 18**, Navarre teaches receiving a request for a special service from the user via the communications network; and locating in a memory, a special ASP associated with the special service request received (col.3, lines 1-45 and col.4, lines 1-23).
32. **As to claim 19**, Navarre teaches receiving an ASP transaction request from the user and transmitting instructions for performing the transaction requested comprise transferring data via the Internet (col.3, lines 1-11).
33. **As to claim 20**, a computer readable medium containing program instructions is inherent to the system of Navarre.
34. **Claims 40 and 42-55** are directed to a system for performing the method of claims 2-16, and are similarly rejected under the same rationale.
35. **Claim 22** is also directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale. Claim 22, however, further recites a memory device and a processor. Navarre teaches a memory device and a processor (fig. 1).
36. **As to claims 23-39**, note the rejection of claims 3-19 above. Claims 23-39 are the same as claims 3-19, except claims 23-39 are system claims and claims 3-19 are method claims.

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***Response to Arguments***

37. Applicant's arguments with respect to claims 2-20, 22-40, and 42-55 have been fully considered, but are deemed to be moot in view of the new grounds of rejection.

***Conclusion***

38. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756.

41. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner for patents

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Van H. Nguyen

  
ST. JOHN COURTENAY III  
PRIMARY EXAMINER